



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of:

Trung T. Doan

Serial No.: 09/652,713

Filed: August 31, 2000

For: CHEMICAL DISPENSING SYSTEM FOR
SEMICONDUCTOR WAFER PROCESSING

§
§ Group Art Unit: 1763
§
§ Examiner: S. MacArthur
§
§ Atty. Docket: 93-0421.04
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TRANSMITTAL OF APPEAL BRIEF AND FEE AUTHORIZATION

Certificate of Mailing (37 C.F.R. § 1.8)

Commissioner for Patents
Washington, D.C. 20231

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4/24/02
Date

Susan Jerome
Signature

Dear Sir:

Enclosed herewith is Applicant's Appeal Brief, submitted in triplicate. The Commissioner is authorized to charge the appropriate fee under 37 C.F.R. § 1.17(c) of \$320.00, as well as any other required fee, to Micron Technology, Inc. Deposit Account No. 13-3092, Order No. 93-0421.04. This transmittal is being submitted in duplicate.

Respectfully submitted,

Charles Brantley II

Charles B. Brantley II, Reg. No. 38,086
Micron Technology, Inc.
8000 S. Federal Way
Mail Stop 525
Boise, ID 83716-9632
(208) 368-4557

**FEE TRANSMITTAL
for FY 2002**

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 320**Complete if Known**

Application Number	09/652,713
Filing Date	August 31, 2000
First Named Inventor	Trung T. Doan
Examiner Name	S. MacArthur
Group / Art Unit	1763
Attorney Docket No.	93-0421.04

METHOD OF PAYMENT (check one)

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit
Account
Number

13-3092, Order No. 93-0421.04

Deposit
Account
Name

Micron Technology, Inc.

- ☒ Charge Any Additional Fee Required
Under 37 CFR 1.16 and 1.17
- ☐ Applicant claims small entity status.
See 37 CFR 1.27

- 2.
- ☐
- Payment Enclosed:

☐ Check ☐ Credit card ☐ Money
Order ☐ Other

FEE CALCULATION**1. BASIC FILING FEE**

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1)

(\$0)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
2 -20 ** =	0	18	0
Independent Claims 1 -3 ** =	0	84	0
Multiple Dependent			0

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	320
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17 (q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$320)

SUBMITTED BY**Complete (if applicable)**

Name (Print/Type)	Charles Brantley	Registration No. Attorney/Agent)	38,086	Telephone	208-368-4557
Signature	Charles Brantley			Date	4/24/02

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#11
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5/3/02

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APPLICANT'S BRIEF ON APPEAL

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Date Signature

Charles B. Brantley II, Reg. No. 38,086
Micron Technology, Inc.
8000 S. Federal Way
Mail Stop 525
Boise, ID 83716-9632
(208) 368-4557

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APPLICANT'S BRIEF ON APPEAL

I. REAL PARTY IN INTEREST

The Applicant, Trung Doan, has assigned his interest in this application to Micron Technology, Inc.

II. RELATED APPEALS AND INTERFERENCES

On February 19, 2002, Applicant submitted a Notice of Appeal as part of the prosecution of application serial no. 09/133,989, which was filed August 14, 1998. Application '989 is the parent application to the current application under appeal. As of the time of submitting this Appeal Brief, Applicant has not yet filed an Appeal Brief in '989.

On February 28, 2002, Applicant submitted an Appeal Brief as part of the prosecution of application serial no. 09/652,969, which was filed August 31, 2000. Application '969 is a divisional of '989 and therefore a sibling of the current application under appeal.

III. STATUS OF THE CLAIMS

Claims 1-43 have been presented during prosecution of the application under appeal.

Claims 1-35 and 38-43 have been canceled.

Claims 36-37 are pending.

Claims 36-37 are rejected under 35 U.S.C. §102 as being anticipated by Hurtig (U.S. Patent No. 5,289,222).

Claims 36-37 are appealed.

IV. STATUS OF THE AMENDMENTS

Applicant filed no amendments subsequent to final rejection.

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V. SUMMARY OF THE INVENTION

The current invention addresses a device for an edge bead. The device comprises a dispenser configured to release a chemical toward the edge bead (specification at p. 3, ln. 17-18; p. 4, ln. 14-16; FIGS. 1&2) and a splash controller around the dispenser (*id.* at p. 3, ln. 18-19; p. 4, ln. 5-6; FIGS. 1&2). The splash controller is physically unattached from the edge bead (FIGS. 1&2) and is configured to draw the chemical toward the splash controller (*id.* at p. 4, ln. 3-5, 16-18). The splash controller is also configured to generate a gas pressure around the edge bead that is lower than an ambient gas pressure (*id.* at p. 3, ln. 3-7, 16-18; FIGS. 1&2) and further configured to physically intercept the chemical (*id.* at p. 4, ln. 8-10; FIGS. 1&2). In a more limited embodiment, the splash controller is around the edge bead (*id.* at p. 4, ln. 16-18; FIG. 2).

VI. ISSUE

There is one issue for determination on appeal: whether the Examiner has failed to satisfy the burden for rejecting the claims as being anticipated by Hurtig.

VII. GROUPING

Applicant defines the following group of claims for consideration upon this appeal. This group corresponds to the issue listed above.

Group 1: claims 36-37.

VIII. ARGUMENT: The Examiner has failed to satisfy the burden for rejecting the claims as being anticipated by Hurtig.

The Examiner rejected claims 36-37 as being anticipated by Hurtig. Applicant contends that the Examiner has misinterpreted Hurtig and that a careful reading of that reference and the limitations for claim 36 demonstrates that Hurtig fails to anticipate the claims. Applicant further contends that the Examiner's rejection is based on a supposition as to what is inherent in the

technology, wherein the supposition lacks support in the record and is therefore not in accordance with case precedent. Moreover, Applicant contends that the Examiner has engaged in piecemeal and generally incomplete examination in contradiction to the very policies set forth by the Patent and Trademark Office (PTO). Applicant concludes that any or all of these contentions demonstrate a failure to meet the burden for rejection and are sufficient to warrant the Board reversing the Examiner and allowing the claims.

A. Examiner has misinterpreted Hurtig

In rejecting claims 36-37 as being anticipated by Hurtig, the Examiner attempted to analogize Hurtig's splash guard (element 104B) to claim 36's splash controller. (Office Action dated 10/16/01 at p. 2.) However, a careful reading of the reference and the claim limitations demonstrates that the Examiner has misinterpreted Hurtig and that Hurtig in fact fails to disclose at least some of the claim limitations.

Claim 36, for instance, requires that the splash controller be configured to *draw toward itself* a particular chemical. This is in addition to a limitation that the splash controller be configured to physically intercept the chemical. Hurtig's text and illustrations indicate that its element 104B is a shaped material that may arguably be configured to guard against splashing. However, the Examiner has cited no portion of the Hurtig that indicates its guard is configured to draw toward itself any chemical. As a result, the Examiner has failed to meet the burden for rejecting this claim.

Moreover, Applicant contends that the Examiner *cannot* meet the burden for rejection relying on Hurtig. It is noteworthy that Hurtig discloses other components -- drain lines 105, 106, 405, and 406 -- that are configured to draw a chemical toward themselves and away from the splash guard. (See Hurtig at col. 2, ln. 7-13; col. 3, ln. 44-47; FIGS. 1, 2, 4.) Given their location in relation to Hurtig's splash guard, having both the drain lines and splash guard draw chemicals toward themselves would result in a device whose components compete and interfere with each other, as the chemicals would be drawn in opposing directions. Thus, because the Examiner's interpretation results in an unworkable device, such an interpretation is untenable. A more reasonable interpretation of Hurtig results in the conclusion that the splash guard does not, should not, and cannot draw toward itself any chemical. Such an interpretation discloses only

the exact opposite of the relevant claim 36 limitation. As a result, Hurtig cannot be read to anticipate claim 36 and its dependent claim 37.

B. Examiner's assumptions concerning inherent features fail to meet case precedent standards

The Examiner's rejection fails in regard to another limitation of claim 36. Specifically, claim 36 also requires that its splash controller be configured to generate around the edge bead a gas pressure that is lower than an ambient gas pressure. The Examiner guessed that Hurtig's splash guard inherently generates such pressure. (Office Action dated 10/16/01 at p. 2.)

Recent case precedent highlights the impropriety of the Examiner's conduct. In *In re Zurko* (258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001)), the PTO rejected Zurko's claims, admitting that the claim limitations were not explicitly disclosed by the cited art but announcing that the limitations were inherent based on the PTO's assumptions concerning the technology. (See *id.* at 1695.) In reversing the PTO, the Court held that the PTO "cannot simply reach conclusions based on its own understanding or experience." (*Id.* at 1697.) Rather, the Court required that the PTO "point to some concrete evidence in the record" to support its findings concerning aspects of the relevant technology. (*Id.* For the Board's convenience, a copy of *Zurko* is included in an appendix to this Appeal Brief.)

The facts on appeal are analogous: the Examiner effectively admitted that Hurtig fails to expressly address the pressure-generating quality of the piece of shaped material that forms Hurtig's splash guard; and the Examiner attempted to make up for this failure by announcing that such a quality is inherent. The Examiner's conduct is legally improper given the standards of *Zurko* and is tantamount to an invitation for reversal by the Board or by the Court. Accordingly, Applicant does in fact request that the Board reverse the Examiner and allow claim 36 and its dependent claim 37.

C. The piecemeal and incomplete nature of Examiner's rejection favors reversing the Examiner as a matter of policy

A brief review of the appealed application's prosecution history is helpful in order to further demonstrate the Examiner's problems in satisfying the burden for rejection as well as binding standards. In the Preliminary Amendment – filed as part of this divisional application's original documents – Applicant cancelled all but seven claims. Specifically, Applicant retained only claims 34-37 and 41-43 based on a restriction requirement in the parent application, wherein the parent's examiner found those claims to be patentably distinct from others. (Office Action dated 3/21/00 for U.S.App. Ser. No. 09/133,989 at p. 2. For the Board's convenience, a copy of this Office Action has been included in an appendix to this Appeal Brief.) Despite that finding, the current Examiner chose to reject the claims in the appealed application under obviousness-type double patenting. (Office Action dated 1/19/01 at p. 2.) In doing so, the Examiner presented the exact opposite argument from the one raised in the parent application, indicating that the claims pending at that point were *not* patentably distinct from others in the original application. Applicant was then required to point out the inconsistency (Response submitted 7/19/01 at p.2), and the Examiner has apparently withdrawn that argument.

In rejecting certain claims as being anticipated by Hurtig, the Examiner specifically enumerated claim 34 (an independent claim), skipped claim 35 (which depends upon claim 34), specifically enumerated claim 36 (which depends upon claim 35), and specifically enumerated claim 37 (which depends upon claim 36). (Office Action dated 1/19/01 at p. 2.) The Examiner did reject claim 35 based on another reference. (*Id.*) The Examiner did not reject claims 36-37 based on any reference other than Hurtig.

In response, Applicant pointed out that the sole basis for rejecting claims 36 and 37 (Hurtig) was not used to reject the claim on which they immediately depend (claim 35). (Response submitted 7/19/01 at p.3.) Accordingly, Applicant cancelled all but claims 36-37 and amended claim 36 to independent form, expressly incorporating the subject matter of claim 35 as well as 34. (*Id.* at p. 1-2.) Thus, the claims should have been in condition for allowance.

However, the Examiner's next Office Action was a final Office Action, in which the Examiner rejected claims 36-37, only then applying Hurtig to the matters originally presented in

claim 35 that are now expressly incorporated into claim 36. Such conduct impacts on the PTO's own standards set forth in MPEP. Significantly, section 707.07 of the MPEP is entitled

Completeness and Clarity of Examiner's Action.

(Emphasis in original.) The text of that section subsequently states:

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection *fully* and clearly stated

(*Id.* at 707.07(d) (emphasis added).)

Other portions of the MPEP echo this requirement:

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.

(*Id.* at 706.02(j).) Although this excerpt appears in a section addressing 35 U.S.C. 103 rejections, Applicant contends the language is applicable to rejections made under any basis. For example, the reasoning in 706.02(j) appears to justify the admonition in section 707.07(g), which is directly relevant to this appeal:

Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on *all valid grounds available*.

(*Id.* (bold emphasis in original, italicized emphasis added.) For the Board's convenience, the cited portions of the MPEP are included in an Appendix to this Appeal Brief.)

With these standards in mind, it is significant that the prosecution history discussed above indicates that the Examiner was capable of applying *Hurtig* to the claims. The history further demonstrates that the Examiner did in fact apply *Hurtig* to all of related claims 34-37 except for claim 35. The prosecution history also shows that the Examiner was capable of rejecting claim 35, having done so using a reference other than *Hurtig*. In addition, the prosecution history shows that the Examiner was required to keep track of no more than seven claims during

prosecution. Nevertheless, the Examiner failed to address Hurtig's application to the matters in claim 35 until the final Office Action – after they has been expressly incorporated into claim 36. This left Applicant no option but to incur expense in defending the claims. Moreover, it is noteworthy that a significant majority of the Examiner's latest argument was lifted directly from the first Office Action. (*Compare* Office Action dated 1/19/01 at p. 3 *with* Office Action dated 10/16/01 at p. 2.) The only difference in the latest argument is the addition of a single sentence – the one in which the Examiner expounds upon what is believed to be inherent. (*Id.*) In addition to failing to meet the standards of case precedent (*see Zurko*), such a statement requires absolutely no effort in searching for and citing concrete evidence in the record.

Thus, given (1) the small number of pending claims; (2) the Examiner's ability to apply Hurtig, including applying Hurtig to a claim upon which claim 35 depends and to claims that depend upon claim 35; (3) the Examiner's ability to articulate a rejection for claim 35; and (4) the substantial similarity between the Examiner's first and final arguments, with the only difference requiring little if any effort of the Examiner; Applicant contends that the Examiner's failure to render even an arguably proper rejection of claims 36-37 under Hurtig until the final Office Action is the epitome of piecemeal examination.

Further, such piecemeal examination combined with the Examiner's focus on non-issues such as a double patenting rejection in a divisional application demonstrate a general failure to promptly, properly, and fully communicate all valid bases for a rejection. As a result, the Examiner's actions suffer from incompleteness. Further, because of the Examiner's conduct, Applicant has not been given a fair opportunity to reply. Such conduct conflicts with the policies and their underlying basis outlined by the PTO itself, thereby warranting a reversal by the Board and allowance of the claims.

D. Conclusion

Applicant's arguments presented above demonstrate that the Examiner's interpretation of Hurtig is untenable in that it lacks support in Hurtig's specification and results in an unworkable device. Applicant's remarks further show that the Examiner's baseless assumption about Hurtig's inherent qualities fails to meet the standards of case precedent. Moreover, The Examiner's failure to timely address all relevant bases for rejection result in piecemeal and

incomplete examination. Any or all of these points demonstrate the Examiner's failure to meet the burden for rejection. Accordingly, Applicant respectfully requests that the Board withdraw the rejections and allow the claims.

Respectfully submitted,

A handwritten signature in black ink that reads "Charles Brantley". The signature is written in a cursive style with a large, sweeping flourish at the end.

Charles Brantley
Registration No. 38,086
Micron Technology, Inc.
8000 S. Federal Way
Boise, ID 83716-9632
(208) 368-4557
Attorney for Applicant

Appendix 1: Copy of Involved Claims

36. A device for an edge bead, comprising:

a dispenser configured to release a chemical toward said edge bead; and

a splash controller around said dispenser, physically unattached from said edge

bead, and configured to draw said chemical toward said splash controller, wherein

said splash controller is configured to generate a gas pressure around said edge

bead that is lower than an ambient gas pressure, and wherein said splash

controller is configured to physically intercept said chemical.

37. The device in claim 36, wherein said splash controller is around said edge bead.

Appendix 2:

In re Zurko 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001)

ntly refers in its advertising to the fact
s cards are "holographically enhanced,"
romotion is simply as one more feature
cards, along with items such as "tamper
unt foil packaging" and "in-your-face
graphy." Even in those instances in
reference is made to the "trademark
ram," such as "the Upper Deck trade-
hologram means it's the real thing," the
ence is that the presence of a hologram
se insures a genuine (non-counterfeit)
act, not that it serves as a source indica-
or the cards.

ie four unsolicited letters from customers
reinforce our opinion that there is no rec-
tion of the mere presence of holograms
he cards as a trademark, rather than as a
re of the cards. The suggestions in these
rs for new hologram designs or new series
hich a hologram is present constitute evi-
ce of no more than the fact that consumers
aware that applicant's trading cards in-
le, as an element thereof, a hologram. We
ee with the Examining Attorney that these
gestions for new hologram designs "can-
be interpreted as meaning that these con-
ners recognize that any hologram device
would be a source indicator simply be-
se they recognize that applicant applies ho-
grams to trading cards." (Brief, p. 15).

The sales and advertising figures for appli-
nt's trading cards per se are equally uncon-
vincing. While sales figures may be indicative
the commercial success of applicant's prod-
ts, they do not demonstrate that the holo-
ams used thereon have acquired distinctiveness
as an indication of the source of the
rds. See *In re Pingel Enterprise Inc.*, 46
SPQ2d 1811 (TTAB 1998). Promotional and
vertising expenditures for the cards per se
re similarly unconvincing without concurrent
vidence of promotion of the hologram device
s a trademark.

We find the circumstances here similar to
prior cases which have found an absence of
vidence of the promotion and consequent
ecognition by the public of the designation
ought to be registered as a trademark. See *In re*
Edward Ski Products, Inc., 49 USPQ2d
2001 (TTAB 1999) (no evidence that configu-
ration of ski mask either promoted or recog-
nized by purchasers as an indication of ori-
gin); *In re Bennetton Group S.p.A.*, 48
USPQ2d 1214 (TTAB 1998) (evidence insuf-
ficient to show that green rectangle back-

ground design promoted in and of itself or
recognized by purchasers as trademark for
clothing items to which it is applied); *In re*
Pingel Enterprise Inc., *supra*, (absence of ad-
vertising or promotion of trademark signifi-
cance of product configuration makes con-
sumer recognition as trademark unlikely).
Here, not only is there minimal evidence that
applicant has promoted the presence of a ho-
logram per se on its trading cards, regardless
of design or content, as an indication of ori-
gin, but, even more significantly, there is no
competent evidence of consumer recognition
of the hologram as a trademark.

Moreover, we have the counterbalancing
effect of the similar use of holograms by com-
petitors in the field. As pointed out earlier,
evidence has been made of record showing
the use by others of comparable hologram de-
vices on trading cards. While applicant may
argue that these are not trademark uses, the
common use of holograms for non-trademark
purposes means that consumers would be less
likely to perceive applicant's uses of holo-
grams as trademarks. Holograms in general
have an anti-counterfeiting function; applicant
has admitted that even its hologram serves
this purpose. Furthermore, while applicant
may argue that every trademark has an anti-
counterfeiting function, the opposite is not
true. Not every anti-counterfeiting device
functions as a trademark. This is blatantly ob-
vious from the evidence of record showing
common use of holograms on a variety of
items for anti-counterfeiting and verification
purposes, but not source identification.

Accordingly, we find that applicant has
failed to establish that the mere presence of its
hologram device, and not in connection with
the design, location, content or other charac-
teristics of any particular hologram, functions
as a trademark for trading cards.

Decision: The refusals to register under
Section 1 on the ground that applicant is seek-
ing to register more than one mark and under
Sections 1, 2, and 45 on the ground that the
hologram device of applicant fails to function
as a trademark are affirmed.

In re Zurko

U.S. Court of Appeals
Federal Circuit

No. 96-1258

Decided August 2, 2001

PATENTS

[1] Patentability/Validity — Obviousness
— Combining references (§ 115.0905)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Judicial review — Stan-
dard of review — Patents
(§ 410.4607.09)

Decision of Board of Patent Appeals and
Interferences sustaining obviousness rejection
of patent application for method of improving
security in computer system is reversed, even
though board's factual findings underlying its
determination are reviewed under "substantial
evidence" standard, since prior art references
relied upon by board do not teach limitation
requiring communications between user and
"trusted" environment along "trusted" path,
and since deficiencies of references cannot be
remedied by reliance upon additional combi-
nation of alternative references cited for first
time on appeal, or by board's general conclu-
sion, unsupported by evidence in record, that
requiring communication with trusted envi-
ronment over trusted path would be "basic
knowledge" or "common sense" to person of
ordinary skill in art; although board's exper-
tise alone may provide sufficient support for
conclusions as to peripheral issues, its core
factual findings in patentability determinations
must be supported by concrete evidence in
record.

On remand from the U.S. Supreme Court.

Patent application of Mary E. Zurko, Tho-
mas A. Casey Jr., Morie Gasser, Judith S.
Hall, Clifford E. Kahn, Andrew H. Mason,
Paul D. Sawyer, Leslie R. Kendall, and Steven
B. Lipner, serial no. 07/479,666 (method for
improving security in a computer system).
Board of Patent Appeals and Interferences
sustained examiner's rejection of application
under 35 U.S.C. § 103. The U.S. Court of Ap-

peals for the Federal Circuit reversed on appeal (42 USPQ2d 1476). On rehearing en banc, the Federal Circuit held (46 USPQ2d 1691) that proper standard of review for fact findings underlying patentability determinations by Patent and Trademark Office is "clearly erroneous" standard, rather than more deferential standard found in Administrative Procedure Act. The U.S. Supreme Court reversed the Federal Circuit's en banc decision and remanded, holding (50 USPQ2d 1930) that PTO's findings of fact must be reviewed under either "substantial evidence" or "arbitrary and capricious" APA standards of review. On remand, the Federal Circuit again reverses board's decision.

Linda Moncys Isacson, associate solicitor, John M. Whealan, solicitor, and Kenneth R. Corsello and Thomas J. Finn, associate solicitors, U.S. Patent and Trademark Office, Arlington, Va., for Commissioner of Patents and Trademarks.

John F. Sweeney, Michael O. Cummings, Jon T. Hohenthanner, Israel Blum, Steven F. Meyer, and Brenda Pomerance, of Morgan & Finnegan, New York, N.Y.; Irene Kosturakis and Russell T. Wong, of Compaq Computer Corp., Houston, Texas; Ernest Gellhorn, Washington, D.C.; Janice M. Mueller, of Suffolk University Law School, Boston, Mass.; Ronald C. Hudgens, of Digital Equipment Corp., Maynard, Mass., for Mary E. Zurko et al.

Before Newman, circuit judge, Archer, senior circuit judge, and Michel, circuit judge.

Archer, S.J.

This case is before us on remand from the Supreme Court of the United States. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) ("Zurko III"). In *Zurko III*, the Court reversed our judgment and remanded the case because we had reviewed the factual findings of the Board of Patent Appeals and Interferences ("Board") for clear error, an incorrect standard of review.

The Board decision at issue, *Ex parte Zurko*, No. 94-3967 (Bd. Pat. Apps. & Int. Aug. 4, 1995), sustained the rejection of U.S. Patent Application No. 07/479,666 ("the '666 application") under 35 U.S.C. § 103 (1994). In our initial review of this decision, we determined that the Board's findings were clearly erroneous and we reversed. *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed.

Cir. 1997) ("*Zurko I*"). At the Commissioner's suggestion, we then reheard this case en banc to reconsider the question of the appropriate standard of review. The Commissioner argued that Board findings should be reviewed under the standards of the Administrative Procedure Act (APA), namely the substantial evidence or arbitrary and capricious standard. 5 U.S.C. § 706 (1994). The en banc court held, however, that clear error was the correct standard of review for Board findings of fact and adopted the conclusions of the original panel decision. *In re Zurko*, 142 F.3d 1447, 46 USPQ2d 1691 (Fed. Cir. 1998) ("*Zurko II*").

The Commissioner then petitioned for review by the Supreme Court, and the Court reversed, holding that Board findings of fact must be reviewed under the APA standards of review. The Court did not specify which APA standard of review to apply, substantial evidence or arbitrary and capricious. We subsequently decided this question in *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000), and held that substantial evidence is the correct APA standard of review for Board factual findings.

We now revisit the merits of our decision in *Zurko I*, applying the proper APA standard of review. In doing so, we conclude that the outcome of this case does not change with the application of this new standard of review. Because the factual findings underlying the Board's decision are not supported by substantial evidence, we reverse.

BACKGROUND

The '666 application concerns a method for more efficiently creating a secure computer environment. Secure, or "trusted," computer environments employ trusted software designed to preclude unauthorized users and to prevent unintended or unauthorized commands. Such trusted software is often quite costly, compared to untrusted software, so it is desirable to minimize the amount of trusted software in the system. Applicants claim a method for processing trusted commands with a minimum of trusted software.

Representative claim one reads as follows:

1. A machine-executed method for executing a trusted command issued by a user on a computer system, the computer system including an untrusted computing environment and a trusted computing environment, said method comprising the steps of:

Zurko I"). At the Commission, we then reheard this case en banc to consider the question of the appropriate standard of review. The Commission's Board findings should be reviewed under the standards of the Administrative Procedure Act (APA), namely the substantial evidence, arbitrary and capricious standard. 5 (1994). The en banc court held, without clear error, that the correct standard for Board findings of fact and conclusions of the original panel was *In re Zurko*, 142 F.3d 1447, 46 (11 Fed. Cir. 1998) ("*Zurko II*"). The Commissioner then petitioned for rehearing before the Supreme Court, and the Court affirmed that Board findings of fact were reviewed under the APA standards of the Court did not specify which APA standard to apply, substantial evidence, arbitrary and capricious. We subsequently addressed this question in *In re Gart*, 35 USPQ2d 1305, 53 USPQ2d 1769 (Fed. Cir. 1998) and held that substantial evidence is the correct APA standard of review for Board findings.

We revisit the merits of our decision in *Zurko I* by applying the proper APA standard of review. Doing so, we conclude that the outcome in this case does not change with the application of this new standard of review. Because the factual findings underlying the Board's decision are not supported by substantial evidence, we reverse.

BACKGROUND

The application concerns a method for securely creating a secure computer system. Secure, or "trusted," computer systems employ trusted software to exclude unauthorized users and to prevent unintended or unauthorized communication. Trusted software is often quite different from untrusted software, so it is desirable to minimize the amount of trusted software in the system. Applicants claim a method for processing trusted commands with a trusted software.

Claim one reads as follows: "A machine-executed method for executing a trusted command issued by a user in a computer system, the computer system comprising an untrusted computing environment and a trusted computing environment, the method comprising the steps of:

(a) parsing the trusted command in the untrusted computing environment to generate a parsed command;

(b) submitting the parsed command to the trusted computing environment;

(c) displaying a representation of the trusted command to the user through a trusted path;

(d) receiving a signal from the user through a trusted path signifying whether the displayed representation accurately represents the user's intentions;

(e) if the signal signifies that the displayed representation does not accurately represent the user's intentions, then preventing the execution of the parsed command;

(f) if the signal signifies that the displayed representation accurately represents the user's intentions, executing the parsed command in the trusted environment.

As set forth in claim one, applicants' method involves processing and verifying a trusted command using both trusted and untrusted software. A trusted command is first processed by untrusted software to create a parsed command. The parsed command is then submitted to the trusted computer environment. Execution of this command requires verification along a trusted path. The parsed command is relayed to the user along a trusted path, and, if correct, the user can send a confirming signal back along this trusted path, allowing execution of the command. By processing a trusted command in this manner, the applicants contend they reduce the amount of trusted software. The applicants assert that the parsing step generally requires a large amount of software and that performing this step with untrusted software greatly reduces the amount of trusted code required to process a trusted command.

The Board sustained the Examiner's rejection of claims 1, 4, and 5 of the '666 application under 35 U.S.C. § 103 based on two prior art references. The primary reference is the UNIX operating system, as described in the applicants' information disclosure statement ("IDS"). According to this description, the UNIX system employs both untrusted and trusted code. Furthermore, certain commands in a UNIX system may be parsed in an untrusted environment, and then these parsed

commands may be executed by "calling a trusted service that executes in a trusted computing environment."

The secondary reference, also described in applicants' IDS, is Dunford, FILER Version 2.20 ("FILER2"). This program repeats back potentially dangerous commands, requesting confirmation from the user before execution.

Considering the teachings of these two references, the Board concluded that the invention claimed by the '666 application would have been obvious. The Board commented that "the artisan would have been led from these teachings to take the trusted command and parse it in an untrusted environment and submit it to the trusted computing environment, as taught by UNIX, and to display the parsed command to the user for confirmation prior to execution, as suggested by [FILER2]." *Ex parte Zurko*, slip op. at 6-7. According to the Board, this combination would render the claimed invention obvious.

The Board also responded to applicants' arguments that neither reference discloses a trusted path communication to the user and that no teaching of the prior art references motivates the combination of these references to create the claimed invention. The Board said that communication along a trusted path, if not explicit in the prior art, is either inherent or implicit. *Id.* at 7. The Board further adopted the Examiner's assertion that "it is basic knowledge that communication in trusted environments is performed over trusted paths." *Id.* at 8. As for the motivation to combine these references, the Board concluded that it "would have been nothing more than good common sense" to combine the teachings of these references. *Id.* The Board noted that FILER2 taught the verification of dangerous commands in general, suggesting verification of the parsed command submitted to the trusted computing environment in UNIX. Because this verification occurs within a trusted environment, it is "basic knowledge," according to the Board, that this verification would occur along a trusted path. *Id.* at 7-8.

Reviewing the Board's decision in *Zurko I*, we held that "the Board's finding that the prior art teaches, either explicitly or inherently, the step of obtaining confirmation over a trusted pathway [was] clearly erroneous." *Zurko I*, 111 F.3d at 889, 42 USPQ2d at 1478. Indeed, we noted that neither reference relied upon by the Board taught communication with

the user over a trusted pathway. *Id.*, 42 USPQ2d at 1479. We further held that the Board clearly erred in finding that the prior art teaches communicating with the user over both a trusted and an untrusted path. This finding was in conflict with the Board's other finding that trusted communications must be over trusted paths. *Id.* at 890, 42 USPQ2d at 1479.

On remand, applicants urge that we maintain our reversal of the Board's decision, arguing that the decision is legally flawed, or, alternatively, that the Board's factual findings fail under the APA standard of review. The Commissioner responds that we must affirm the Board decision because its findings are supported by substantial evidence in the record.

DISCUSSION

A claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18, 148 USPQ at 467; *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (stating that the inherent teachings of a prior art reference is a question of fact). We review the ultimate legal determination of obviousness without deference. *In re Dembiczak*, 175 F.3d at 998, 50 USPQ at 1616. We review factual findings underlying this determination for substantial evidence. *In re Gartside*, 203 F.3d at 1311-16, 53 USPQ2d at 1772-75.

Substantial evidence is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938); see also *Zurko III*, 527 U.S. at 162, 50 USPQ2d at 1772-75. A review under this standard "involves an examination of the record

as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision." *In re Gartside*, 203 F.3d at 1312, 53 USPQ2d at 1773 (citing *Universal Camera Corp. v. NLRB*, 340 U.S. 474, 487-88 (1951)). In addition, "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." *Consolo v. Fed. Maritime Comm'n.*, 383 U.S. 607, 619-20 (1966).

The substantial evidence standard has been analogized to the review of jury findings, and it is generally considered to be more deferential than the clearly erroneous standard of review. *Zurko III*, 527 U.S. at 162-63, 50 USPQ2d at 1936. The Supreme Court noted in *Zurko III*, however, that this generally recognized difference is "a subtle one," so fine that in its review of case law in the *Zurko III* decision, the Court could not find any other case where a reviewing court had conceded that the standard of review made a difference. *Id.* Moreover, while appellate courts must respect agency expertise, the Court has "stressed the importance of not simply rubber-stamping agency fact finding." *Id.* (citing *Universal Camera*, 340 U.S. at 477-78). Indeed, the Court observed that Federal Circuit judges "will examine [Board fact] findings through the lens of patent-related experience — and properly so, for the Federal Circuit is a specialized Court." *Id.* The Court further noted that this "comparative expertise, by enabling the Circuit better to understand the basis for the [Board's] finding of fact, may play a more important role in assuring proper review than would a theoretically somewhat stricter standard." *Id.*

With this guidance from the Supreme Court in mind, we now reconsider the Board's decision. Applicants urge that we reaffirm our conclusion in *Zurko I*, alleging numerous legal and factual errors in the Board decision. These arguments center around two issues. First, applicants argue that the prior art relied upon by the Board does not disclose one of the limitations of their claimed invention, namely communication between a trusted environment and the user along a trusted path. Second, applicants claim that there is no substantial evidence support for the Board's finding of motivation to combine the cited references to yield the claimed invention. We only need to consider the first issue raised by applicants.

king into consideration evidence that undermines and detracts from the agency's position." *In re Gartside*, 203 F.3d at 1773 (citing *Universal v. NLRB*, 340 U.S. 474, 487-88). In addition, "the possibility of drawing inconsistent conclusions from the evidence does not prevent an administrative action from being supported by substantial evidence." *Consolo v. Fed. Maritime*, 349 U.S. 607, 619-20 (1966).

Substantial evidence standard has been applied in the review of jury findings, and is clearly considered to be more deferential than the clearly erroneous standard of review. *III*, 527 U.S. at 162-63, 509 S.Ct. 936. The Supreme Court noted in *Id.*, however, that this generally recognized standard is "a subtle one," so fine that it is of case law in the *Zurko III* decision that the court could not find any other case where the reviewing court had conceded that the standard of review made a difference. *Id.* While appellate courts must respect the Board's findings, the Court has "stressed the fact that the Board is not simply rubber-stamping its findings." *Id.* (citing *Universal v. NLRB*, 340 U.S. at 477-78). Indeed, the Supreme Court has noted that Federal Circuit judges have "based [Board fact] findings through their patent-related experience — and not on the Federal Circuit is a specialist." *Id.* The Court further noted that the Board's comparative expertise, by enabling it to understand the basis for its findings of fact, may play a more significant role in assuring proper review than would be theoretically somewhat stricter stan-

ards. The guidance from the Supreme Court is that we now reconsider the Board's decisions and urge that we reaffirm our conclusions in *Zurko I*, alleging numerous legal errors in the Board decision. These errors center around two issues. First, we argue that the prior art relied upon by the Board does not disclose one of the limitations claimed in the invention, namely communication between a trusted environment and a trusted path. Second, we argue that there is no substantial evidence in support of the Board's finding of motivation to combine the cited references to yield the invention. We only need to consider the first issue raised by applicants.

[1] As to this first issue, the Commissioner apparently concedes that neither the UNIX IDS disclosure nor FILER2 teaches communications between the user and the trusted environment along a trusted path. Nevertheless, the Commissioner maintains that the Board's findings concerning the content of the prior art are supported by four other references in the record.¹ The Commissioner argues that these additional references describe modified UNIX systems that allow communication over both trusted and untrusted paths. Therefore, the Commissioner argues, the Board's general findings concerning the content of the prior art have substantial evidence support, as does its ultimate conclusion of obviousness.

We are unpersuaded by the Commissioner's arguments. The Board's conclusion of obviousness was based on the UNIX and FILER2 references. The Board's findings with respect to these references simply cannot be supported by the alternative references identified by the Commissioner on remand. To the contrary, these alternative references merely confirm the well-known fact that conventional UNIX systems do not allow communication between the user and the trusted environment along a trusted path. For example, Johrie et al., U.S. Pat. No. 4,918,653, comments that "[s]ome examples of prior art multi-user operating systems which have not provided an effective mechanism for establishing a trusted path include UNIX . . ." Johrie, col. 1, ll. 60-63.

The Commissioner also cannot now mend the Board's faulty conclusion of obviousness by substituting these alternative references for those relied upon by the Board. This new combination of references would constitute a new ground for rejection, not considered or relied upon by the Examiner or the Board. It is well settled that it would be inappropriate for us to consider such a new ground of rejection. *In re Margolis*, 785 F.2d 1029, 1032; 228 USPQ 940, 942 (Fed. Cir. 1986); see also *Koyo Seiko Co., Ltd. v. United States*, 95 F.3d

1094, 1099 (Fed. Cir. 1996) (holding that "[t]he grounds upon which an administrative order must be judged are those upon which the record discloses that its action was based.") (quoting *SEC v. Chenery Corp.*, 318 U.S. 80, 87 (1943)).

Finally, the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. As described above, the Board contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, "it is basic knowledge that communication in trusted environments is performed over trusted paths" and, moreover, verifying the trusted command in UNIX over a trusted path is "nothing more than good common sense." *Ex parte Zurko*, slip op. at 8. We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.² To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. *Baltimore & Ohio R.R. Co. v. Aderdeen & Rockfish R.R. Co.*, 393 U.S. 87, 91-92 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise "[t]he requirement for administrative decisions based on substantial evidence and reasoned findings — which alone make effective judicial review

¹ Specifically, the Commissioner points to Johrie et al., U.S. Pat. No. 4,918,653; E.J. McCauley et al., *KSOS: The Design of a Secure Operating System*, Ford Aerospace and Communications Corp. (1979); Stanley R. Ames, Jr. et al., *Security Kernel Design and Implementation: An Introduction*, IEEE Cat. No. 830700-001 (July 1983); and Simon Wiseman et al., *The Trusted Path Between Smitte and the User*, Proceedings 1988 IEEE Symposium on Security and Privacy (April 18-21, 1988).

² As described above, we cannot accept the Commissioner's invitation to now search the record for references in support of the Board's general conclusions concerning the prior art. Even if any such references could support these conclusions, it would be inappropriate for us to consider references not relied upon by the Board. *In re Margolis*, 785 F.2d at 1032; 228 USPQ at 942.

possible — would become lost in the haze of so-called expertise"). Accordingly, we cannot accept the Board's unsupported assessment of the prior art.

CONCLUSION

The Board's conclusion of obviousness was based on a misreading of the references relied upon and, therefore, lacks substantial evidence support. Accordingly, the Board's judgment is reversed.

REVERSED.

D.W. Mercer Inc. v. Valley Fresh Produce Inc.

U.S. District Court
Middle District of Florida
No. 2:00-cv-294-FTM-29DNF
Decided May 8, 2001

JUDICIAL PRACTICE AND PROCEDURE

[1] Jurisdiction — Personal jurisdiction (§ 405.11)

Jurisdiction — Service of process — Long arm statutes (§ 405.1303)

Allegations of complaint and contents of affidavits are sufficient to establish that defendant corporation is subject to Florida's long-arm statute, Fla. Stat. § 48.193(1)(b), which premises personal jurisdiction on commission of tortious act within state, since those documents show that defendant shipped approximately 1,000 packages of strawberries bearing allegedly infringing trademarks into state; however, documents are not sufficient to show that defendants are subject to Section 48.193(1)(f), which premises personal jurisdiction on injury within state arising out of act or omission outside state, since documents show only economic injury, which is insufficient, without accompanying personal or property injury, to confer personal jurisdiction over non-resident defendants under that subsection.

[2] Jurisdiction — Personal jurisdiction (§ 405.11)

Jurisdiction — Service of process — Long arm statutes (§ 405.1303)

REMEDIES

Monetary — Damages — Personal liability of corporate officials (§ 510.0513)

Allegations of complaint and contents of affidavits are not sufficient to establish that individual defendant, alleged to be dominant force behind co-defendant corporation, is subject to Florida's long-arm statute, Fla. Stat. § 48.193(1)(b), since acts of corporate employee performed in corporate capacity do not form sufficient basis for jurisdiction over corporate employee in his or her individual capacity.

JUDICIAL PRACTICE AND PROCEDURE

[3] Jurisdiction — Personal jurisdiction (§ 405.11)

Non-resident corporation is subject to personal jurisdiction of federal district court in Florida in trademark infringement action, since commission of tortious act alleged in complaint, and corporation's shipment of approximately 1,000 packages of strawberries bearing allegedly infringing trademarks into Florida, are sufficient to establish required minimum contacts, and since, in view of those contacts, assertion of personal jurisdiction over corporation would comport with traditional notions of fair play and substantial justice.

Action by D.W. Mercer Inc. against Valley Fresh Produce Inc. and John A. Cottle for trademark infringement under Lanham Act. On defendants' motion to dismiss for lack of personal jurisdiction, or to transfer. Motion to dismiss granted, without prejudice, as to defendant John A. Cottle.

Jennifer L. Whitelaw, Naples, Fla., for plaintiff.

Lance D. Orloff, of Grant, Genovese & Baratta, Irvine, Calif.; John W. Lewis, of Henderson, Franklin, Starnes & Holt, Ft. Myers, Fla., for defendants.

Steele, J.

Appendix 3

Office Action dated 3/21/00 for U.S.App. Ser. No. 09/133,989



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

PL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/133,989	02/14/98	DOAN	93-0421.03

CHARLES B BRANTLEY II
8000 S FEDERAL WAY
M S 525
BOISE ID 83716-9632

IM22/0321

EXAMINER

EDWARDS, L

ART UNIT	PAPER NUMBER
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1734

4

DATE MAILED: 03/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

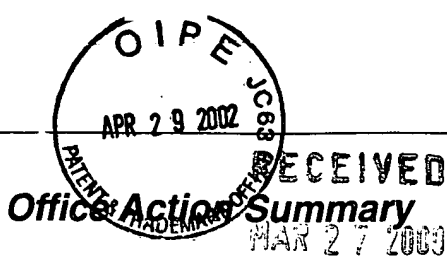
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MAY 02 2002

IC 1700



Application No. 09/133989	Applicant(s) Joan
Examiner L. Edwards	Group Art Unit 1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 and 12-43 is/are pending in the application.
- Of the above claim(s) 34-43 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 and 12-33 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Art Unit: 1734

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 12-33, drawn to a solvent dispenser/suction device, classified in class 118, subclass 50.
- II. Claims 34-37 and 41-43, drawn to a dispenser/splash control device, classified in class 118, subclass 60.
- III. Claims 38-40, drawn to a movable dispenser/movable suction device, classified in class 118, subclass 323.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are deemed independent and distinct inventions in that each invention requires particulars not required by the other invention. For instance, the invention of Group I is to a dispenser/suction device and the invention of Group II is to a dispenser and splash control device which does not require a suction device and could include a housing in combination with the dispenser to control splash. As for the invention of Group III relative to the inventions of Groups I and II, it requires movable parts such as a movable nozzle and a movable suction device as the inventions of Groups I and II do not require any movable parts.

Art Unit: 1734

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Brantley on 3/14/2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 and 12-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-43 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

Specification

The disclosure is objected to because of the following informality: on page 1, line 1, Applicant is suggested to update the history of the former case as to being abandoned or allowed and corresponding patent number(s).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1734

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 12-14, and 16-33 rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Patent No. 8-5825.

The Japanese Patent teaches an apparatus for removing coating from the edge of a substrate comprising means (12) for dispensing a developing solution onto the edge of the substrate and means (11) surrounding the dispensing means for vacuuming excess developing solution and dissolved coating material from the edge of the substrate (See Figs. 1-3). Inherently, the developing solution dispensed from the dispensing means constitutes a solvent as the developing solution permeates the built-up part or edge bead of the coated substrate and removes the built-up part as evidenced by the abstract in the last four lines.

Claims 1, 14-18, 20, 21, 24, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al (JP 56-73579).

Uchida et al teach an apparatus for removing coating from the edge of a substrate comprising means (4) for dispensing a solvent (i.e., water) onto the edge of the substrate and means (5) surrounding the dispensing means for vacuuming excess solvent and dissolved coating material from the edge of the substrate (See Figs. 1-3).

Art Unit: 1734

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19, 22, 23, 25-27, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al (JP 56-73579) in view of Japanese Patent No. 8-5825.

Uchida et al teach an apparatus for removing the thick film part or edge bead of a coated edge comprising a nozzle (4) configured to apply a solvent (i.e., water) to an edge of a substrate, and a vacuum mechanism (5) enveloping the nozzle to remove excess solvent and dissolved coating material from the substrate edge. Uchida et al fail to teach or suggest the vacuum mechanism enveloping the edge of the substrate. However, it was known in the art at the time the

Art Unit: 1734

invention was made, to provide a vacuum mechanism enveloping a solvent dispensing nozzle as well as the edge of a coated substrate in order to facilitate the removal of coating build-up on the edge of a substrate from its top and bottom surface as evidenced by Japanese Patent No. 8-5825. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Uchida et al apparatus to envelop the dispensing nozzle as well as the edge of the substrate with a vacuum mechanism as taught by the Japanese Patent in order to optimize the removal of coating build-up from the edge of the substrate.

With respect to claim 22, Uchida et al teach an apparatus including a coaxial dispenser and suction device provided on the top surface of a coated substrate. Uchida et al are silent concerning providing such an apparatus on the top and bottom of the substrate and further having the suction device encompass both the top and bottom dispensers. However, it was known in the art at the time the invention was made to provide top and bottom dispensers with an encompassing suction device disposed about the dispensers in order to facilitate removal from the top and even the bottom of the coated substrate as evidenced by Japanese Patent No. 8-5825. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Uchida et al apparatus to provide top and bottom dispensers and encompass both dispensers with the suction device in order to completely remove any coating material build-up from the top surface as well any material that reaches the bottom surface of the substrate.

Art Unit: 1734


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent recognizes the state of the art with respect to combined dispenser and suction devices: Bell et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Edwards whose telephone number is (703) 308-4252. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached at (703) 308-3853. The fax phone number for Art Unit 1734 is (703) 305-7115.

Any inquiry of a general nature such as status inquiries should be directed to the Group receptionist whose telephone number is (703) 308-0661.


LAURA EDWARDS
PRIMARY EXAMINER
GROUP 1300
1734

le

March 20, 2000



NOTICE OF DRAFTPERSON'S PATENT DRAWING REVIEW

The drawing filed (insert date) 8/14/98 are:

A. _____ not objected to by the Draftperson under 37 CFR 1.84 or 1.152.

B. _____ objected to by the Draftperson under 37 CFR 1.84 or 1.152 as indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawings must be submitted according to the instructions on the back of this notice.

- | | |
|--|--|
| <p>1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:
Black ink. Color.
_____ Color drawing are not acceptable until petition is granted.
Fig(s) _____
_____ Pencil and non black ink is not permitted. Fig(s) _____</p> <p>2. PHOTOGRAPHS. 37 CFR 1.84(b)
_____ Photographs are not acceptable until petition is granted,
_____ 3 full-tone sets are required. Fig(s) _____
_____ Photographs not properly mounted (must brystol board or photographic double-weight paper). Fig(s) _____
_____ Poor quality (half-tone). Fig(s) _____</p> <p>3. TYPE OF PAPER. 37 CFR 1.84(e)
_____ Paper not flexible, strong, white and durable.
Fig(s) _____
_____ Erasures, alterations, overwritings, interlineations, folds, copy machine marks not acceptable. (too thin)
_____ Mylar, vellum paper is not acceptable (too thin).
Fig(s) _____</p> <p>4. SIZE OF PAPER. 37 CFR 1.84(F): Acceptable sizes:
_____ 21.0 cm by 29.7 cm (DIN size A4)
_____ 21.6 cm by 27.9 cm (8 1/2 x 11 inches)
_____ All drawings sheets not the same size.
Sheet(s) _____</p> <p>5. MARGINS. 37 CFR 18.4(g): Acceptable margins:
Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm
SIZE: A4 Size
Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm
SIZE: 8 1/2 x 11
_____ Margins not acceptable. Fig(s) _____
_____ Top (T) _____ Left (L)
_____ Right (R) _____ Bottom (B)</p> <p>6. VIEWS. CFR 1.84(h)
REMINDER: Specification may require revision to correspond to drawing changes.
_____ Views connected by projection lines or lead lines.
Fig(s) _____
Partial views. 37 CFR 1.84(h)(2)
_____ Brackets needed to show figure as one entity.
Fig(s) _____
_____ Views not labeled separately or properly.
Fig(s) _____
_____ Enlarged view not labeled separately or properly.
Fig(s) _____</p> | <p>7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)
_____ Hatching not indicated for sectional portions of an object.
Fig(s) _____
_____ Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____</p> <p>8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)
_____ Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned, so that the top becomes the right side, except for graphs. Fig(s) _____
_____ Views not on the same plane on drawing sheet. Fig(s) _____</p> <p>9. SCALE. 37 CFR 1.84(k)
_____ Scale not large enough to show mechsansim with crowding when drawing is reduced in size to two-thirds in reproduction.
Fig(s) _____</p> <p>10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)
_____ Lines, numbers & letters not uniformly thick and well defined, clean, durable and black (poor line quality).
Fig(s) _____</p> <p>11. SHADING. 37 CFR 1.84(m)
_____ Solid black areas pale. Fig(s) _____
_____ Solid black shading not permitted. Fig(s) _____
_____ Shade lines, pale, rough and blurred. Fig(s) _____</p> <p>12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.48(p)
_____ Numbers and reference characters not plain and legible.
Fig(s) _____
_____ Figure legends are poor. Fig(s) _____
_____ Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(3) Fig(s) _____
_____ English alphabet not used. 37 CFR 1.84(p)(3) Fig(s) _____
_____ Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig(s) _____</p> <p>13. LEAD LINES. 37 CFR 1.84(q)
_____ Lead lines cross each other. Fig(s) _____
_____ Lead lines missing. Fig(s) _____</p> <p>14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.48(t)
_____ Sheets not numbered consecutively, and in Ababic numerals beginning with number 1. Fig(s) _____</p> <p>15. NUMBERING OF VIEWS. 37 CFR 1.84(u)
_____ Views not numbered consecutively, and in Abrabic numerals, beginning with number 1. Fig(s) _____</p> <p>16. CORRECTIONS. 37 CFR 1.84(w)
_____ Corrections not made from PTO-948 dated _____</p> <p>17. DESIGN DRAWINGS. 37 CFR 1.152
_____ Surface shading shown not appropriate. Fig(s) _____
_____ Solid black shading not used for color contrast.
Fig(s) _____</p> |
|--|--|

COMMENTS:

REVIEWER _____

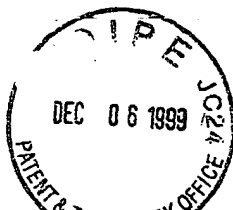
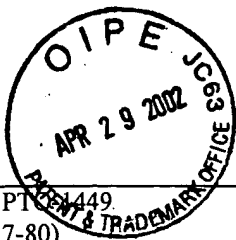
DATE 8/28/98

TELEPHONE NO. 305 8404

ATTACHMENT TO PAPER NO. 4

APPLICANT'S COPY

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Sheet: 1 of: 2

FORM: PT 1449 (REV: 7-80)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	Atty Docket No: 93-0421.03	Serial No: 09/133,989
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (37 CFR 1.98(b)) (use several sheets if necessary)		Applicant: Trung T. Doan	
		Filing Date: 08/14/98	Group: 1762

U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	
Mr	AA 5,952,050	09/14/99	Doan	427	336	
	AB 5,705,223	01/06/98	Bunkofske	427	240	
	AC 5,580,607	12/03/96	Takekuma et al.	427	240	
	AD 5,474,807	12/12/95	Koshiishi	427	240	
	AE 5,444,921	08/29/95	Milina	033	833	
	AF 5,378,511	01/03/95	Cardinali et al.	427	600	
	AG 5,362,608	11/08/94	Flaim et al.	430	327	
	AH 5,358,740	10/25/94	Bornside et al.	427	240	
	AI 5,294,257	03/15/94	Kelly et al.	118	052	
	AJ 5,289,222	02/22/94	Hurtig	354	317	
	AK 5,279,926	01/18/94	Chandler et al.	430	311	
	AL 5,238,713	08/24/93	Sago et al.	427	240	
	AM 5,151,219	09/29/92	Salamy et al.	252	364	
	AN 5,103,102	04/07/92	Economou et al.	250	492.2	
	AO 5,013,586	05/07/91	Cavazza	427	240	
	AP 4,899,685	02/13/90	Kawakami	118	050	
	AQ 4,886,728	12/12/89	Salamy et al.	430	331	
	AR 4,838,979	06/13/89	Nishida et al.	156	345	
	AS 4,790,262	12/13/88	Nakayama et al.	118	052	
	AT 4,732,785	03/22/88	Brewer	427	240	
	AU 4,685,975	08/11/87	Kottman et al.	134	033	
	AV 4,668,334	05/26/87	Doornveld	156	640	
	AW 4,611,553	09/16/86	Iwata et al.	118	050	
	AX 4,576,796	03/18/86	McCormick	422	099	
	AY 4,518,678	05/21/85	Allen	430	311	
	AZ 4,510,176	04/09/85	Cuthbert et al.	427	082	
	BA 4,393,807	07/19/83	Fujimura et al.	118	501	
	BB 4,113,492	09/12/78	Sato et al.	096	067	
✓	BC 3,834,083	09/10/74	Hoshi et al.	051	057	

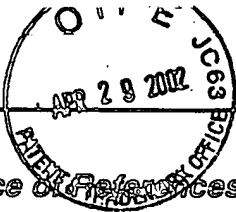
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FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation Yes	Translation No
Mr	BD 56-73579	06/18/81	Japan	B05D 7/04	G03C 1/74	<input checked="" type="checkbox"/>	<input type="checkbox"/>
	BE					<input type="checkbox"/>	<input type="checkbox"/>
	BF					<input type="checkbox"/>	<input type="checkbox"/>

Examiner J. S. K.

Date Considered: 3/2000



Notice of References Cited

Application No.

09/133989

Applicant(s)

Doan

Examiner

L. Edwards

Group Art Unit

1734

Pag 1 of 1

U.S. PATENT DOCUMENTS

*	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	3900866	8-19-75	Bull et al		
B					
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

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FOREIGN PATENT DOCUMENTS

*	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N	8-5825	1-12-96	Japan	—	—	—
O						
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

*	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

* A copy of this reference is not being furnished with this Office action.
(See Manual of Patent Examining Procedure, Section 707.05(a).)



Appendix 4

Cited excerpts from the MPEP

§707.07

§707.07(d)

§706.02(j)

§707.07(g)

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Decisions found only in patented files should be cited only when there is no published decision on the same point.

When a Commissioner's order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such as a specific issue of the *Journal of the Patent and Trademark Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

707.07 Completeness and Clarity of Examiner's Action

37 CFR 1.104. Nature of examination.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

707.07(a) Complete Action on Formal Matters

Forms are placed in informal applications listing informalities noted by the Draftsperson (form PTO-948) and the Office of Initial Patent Examination (form PTO-152). Each of these forms comprises an original for the file record and a copy to be mailed to applicant as a part of the examiner's first action. They are specifically referred to as attachments to the action and are marked with its paper number. In every instance where these forms are to be used, they should be mailed with the examiner's *first* action, and any additional formal requirements which the examiner desires to make should be included in the *first* action.

When any formal requirement is made in an examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to 37 CFR 1.111(b) and state that a complete reply must either comply with all formal requirements or specifically traverse each requirement not complied with.

§ 7.43.03 Allowable Subject Matter, Formal Requirements Outstanding

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements, or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Examiner Note:

This paragraph would be appropriate when changes must be made prior to allowance. For example, when there is a requirement for drawing corrections that have to be submitted for approval or when corrections to the specification have to be made prior to allowance.

707.07(b) Requiring New Oath

See MPEP § 602.02.

707.07(c) Draftsperson's Requirement

See MPEP § 707.07(a); also MPEP § 608.02(a), (e), and (s).

707.07(d) Language To Be Used In Rejecting Claims

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as broader than the enabling disclosure, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

See MPEP § 706.02 (i), (j), and (m) for language to be used.

Everything of a personal nature must be avoided. Whatever may be the examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he or she should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he or she express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him or her the claims allowed.

706.02(j) Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd.

Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) - § 706.02(l)(3) for a discussion of prior art disqualified under 35 U.S.C. 103(c).

706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c)

¶ 7.37.08 Unpersuasive Argument: Arguing Limitations Which Are Not Claimed

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., [1]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner Note:

1. In bracket 1, recite the features upon which applicant relies, but which are not recited in the claim(s).
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.09 Unpersuasive Argument: Intended Use

In response to applicant's argument that [1], a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of intended use.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.10 Unpersuasive Argument: Limitation(s) in Preamble

In response to applicant's arguments, the recitation [1] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner Note:

1. In bracket 1, briefly restate the recitation about which applicant is arguing.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.11 Unpersuasive Argument: General Allegation of Patentability

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.12 Unpersuasive Argument: Novelty Not Clearly Pointed Out

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.13 Unpersuasive Argument: Arguing Against References Individually

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.